IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTORS: David G. Kuehr-McLaren et al.

APPLICATION NO.   10/706,464

FILED: November 12, 2003   Examiner: J. B. Dunham

CASE NO.   RSW920010117US1   Group Art Unit: 3625

TITLE: METHOD, SYSTEM, AND COMPUTER PROGRAM PRODUCT
                           FOR FILTERING PARTICIPANTS IN ELECTRONIC
                           TRANSACTIONS USING PRIVACY POLICIES

FILED ELECTRONICALLY ON October 10, 2006

MAIL STOP APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Board of Patent Appeals and Interferences

<u>APPELLANTS' BRIEF</u>

This Appeal Brief is in furtherance of the Notice of Appeal filed in this case on

August 7, 2006. The Commissioner is authorized to charge the fee for filing of this

Appeal Brief to Deposit Account No. 09-0461.

1. REAL PARTY IN INTEREST

The present application is assigned to International Business Machines Corporation, having its principal place of business at New Orchard Road, Armonk, New York 10504. Accordingly, International Business Machines Corporation is the real party in interest.

2. RELATED APPEALS AND INTERFERENCES

The Appellants, assignee, and the legal representatives of both are unaware of any other appeal or interference which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

3. STATUS OF CLAIMS

A. Claims canceled: None

B. Claims withdrawn from consideration but not canceled: None

C. Claims pending: 1-12

D. Claims allowed: none

E. Claims rejected: 1-12

F. Claims appealed: 1-12

Appealed claims 1-12 as currently pending are attached as the Claims Appendix hereto.

4.　　　STATUS OF AMENDMENTS

A Reply under 37 C.F.R. §1.111 was filed on December 23, 2005; no claim amendments were made. In response, the Examiner issued the final Office Action appealed herein.

5.　　　SUMMARY OF THE CLAIMED SUBJECT MATTER

Claim 1: A method of conducting electronic commerce transactions among participants in an E-marketplace, comprising the steps of: obtaining privacy-use information for each participant (Page 9, lines 14-18); comparing the privacy-use information for each participant to determine matches (Page 10, lines 1-5); and only allowing transactions to occur between participants who have matching privacy-use information (Page 10, line 11 – Page 12, line 2).

Claim 5: A system for conducting electronic commerce transactions among participants in an E-marketplace, comprising: means for obtaining privacy-use information for each participant (Page 9, lines 14-18); means for comparing the privacy-use information for each participant to determine matches (Page 10, lines 1-5); and means for only allowing transactions to occur between participants who have matching privacy-use information (Page 10, line 11 – Page 12, line 2).

Claim 9: A computer program product recorded on computer-readable storage medium, for conducting electronic commerce transactions among participants in an E-marketplace, comprising: computer-readable means for obtaining privacy-use information for each participant (Page 9, lines 14-18); computer-readable means for comparing the

privacy-use information for each participant to determine matches (Page 10, lines 1-5); and

computer-readable means for only allowing transactions to occur between participants who

have matching privacy-use information (Page 10, line 11 – Page 12, line 2).

The present claimed invention focuses on improving security in an E-Marketplace

for a consumer. This is accomplished, in part, by determining a consumer's privacy use

information, comparing this privacy use information to those of the various vendors of the

E-Marketplace, and <u>only allowing transactions</u> between a consumer and a vendor with

<u>matching privacy-use information</u>.

6.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellants request the Board to review the following rejections:

1.   Rejection of Claims 1-12 under 35 U.S.C. §102(e) as being anticipated by

Epling (U.S. Patent Application Publication No. 2005/0091101).

7.   ARGUMENT

The Cited Prior Art Does Not Anticipate the Claimed Invention

<u>The Examiner Has Not Established a *Prima Facie* Case of Anticipation</u>

The MPEP and case law provide the following definition of anticipation for the

purposes of 35 U.S.C. §102:

> A claim is anticipated only if each and every element as set forth in the claim
> is found, either expressly or inherently described, in a single prior art
> reference. MPEP §2131 citing *Verdegaal Bros. v. Union Oil Company of
> California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987)

The present invention solves the problem of assuring secured transactions in an E-Marketplace. By allowing a consumer to set their desired level of security for a transaction, and matching a consumer's level of desired security with that of a selected vendor, a consumer is only provided with vendors who meet their desired level of security. Specifically, Claim 1 recites "comparing the privacy-use information for each participant to determine matches; only allowing transactions to occur between participants who have matching privacy-use information" (lines 4-6). Each additional independent claim (Claims 5 and 9) states a variation of these limitations. These limitations render the present claimed invention as novel over the prior art of record, including Epling.

The Examiner asserts that Epling teaches comparing the privacy use information for each participant to determine matches as well as only allowing transactions to occur between participants who have matching privacy use information. The Examiner is incorrect in this assertion. Epling does in fact allow transactions to occur between participants who have non-matching privacy use information, specifically stating so in the explanation of Figure 2 (in particular, paragraphs [0044] and [0050]).

The overall system of Epling is focused on notifying a user of the privacy policies of a particular website (e.g., does the website collect personal information, does the website share this personal information with third parties). The user compiles a prioritized document listing the user's security concerns in order from most important to least important. When visiting a web site, this user compiled list is compared to a privacy listing of the web site. Any conflicting security issues are highlighted on the

user's list. A new document is created for viewing by the user indicating only those security concerns which are conflicting. Paragraph [0044] summarizes the user's interaction with this newly created document, specifically reciting:

> At block **218**, the user may then opt to see the results by responding to the notification set in block **216** by, for example, clicking on a notification icon or responding to a popup box. If the user wants to see the results of the comparison ("Yes" branch, block **218**), then the results are displayed by the UI module **122** at block **220**. If the user does not want to see the results ("No" branch, block **218**), then the user continues to browse the site at block **224**.

Here, the user is presented with the option to view the results or to continue on to the web site. If the user opts to continue to the web site, the user never sees the results and therefore can access the web site even if the privacy use information does not match.

Alternatively, if the user does opt to view the results, the user is presented with the decision to exit the web site or to continue browsing the web site. Specifically, Epling paragraph [0050] recites:

> After the user views the policy conflicts at block **220**, the user may wish to exit the Web site ('No' branch, block **222**) or continue to browse the Web site at block **224** ('Yes' branch, block **222**).

Ultimately, if the privacy-use information does not match, the user is responsible for deciding whether to visit the web site or not. However, transactions can still occur between participants without matching privacy-use information. This teaches away from the present claimed invention where the user can never access the web site if the privacy-use information does not match. In the present invention, the user is not even provided the option of participating in a transaction where the privacy-use information does not match as only participants with matching privacy-use information are made available to the user.

Since the present claimed invention is neither taught nor suggested by the cited

art, the Board is respectfully requested to reconsider and withdraw the rejection of

Claims 1-12 under 35 U.S.C. §102(e) as being anticipated by Epling.

8.   CONCLUSION

For the foregoing reasons applicants respectfully request this Board to overrule

the Examiner's rejections and allow Claims 1-12.

Respectfully submitted,

October 10, 2006
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CLAIMS APPENDIX

CLAIMS INVOLVED IN THIS APPEAL:

1. (Original) A method of conducting electronic commerce transactions among participants in an E-marketplace, comprising the steps of:

obtaining privacy-use information for each participant;

comparing the privacy-use information for each participant to determine matches; and

only allowing transactions to occur between participants who have matching privacy-use information.

2. (Original) The method of claim 1, wherein said obtaining step comprises at least the step of requiring each participant in the E-marketplace to present to the E-marketplace their P3P policy.

3. (Original) The method of claim 1, wherein said obtaining step comprises at least the steps of:

presenting each participant with questions that elicit their privacy-use information; and

storing the elicited privacy-use information for use in said comparing step.

4. (Original) The method of claim 3, wherein said privacy-use information includes at least one of: use information pertaining to elicited email addresses; use information

pertaining to financial information; use of personal information; use of business information, and the delivery of advertising to the participant.

5. (Original) A system for conducting electronic commerce transactions among participants in an E-marketplace, comprising:

means for obtaining privacy-use information for each participant;

means for comparing the privacy-use information for each participant to determine matches; and

means for only allowing transactions to occur between participants who have matching privacy-use information.

6. (Original) The system of claim 5, wherein said means for obtaining comprises at least means for requiring each participant in the E-marketplace to present to the E-marketplace their P3P policy.

7. (Original) The system of claim 5, wherein said means for obtaining comprises at least:

means for presenting each participant with questions that elicit their privacy-use information; and

means for storing the elicited privacy-use information for use in said comparing step.

8. (Original) The system of claim 7, wherein said privacy-use information includes at least one of: use information pertaining to elicited email addresses; use of information pertaining to financial information; use of personal information; use of business information, and the delivery of advertising to the participant.

9. (Original) A computer program product recorded on computer-readable storage medium, for conducting electronic commerce transactions among participants in an E-marketplace, comprising:

computer-readable means for obtaining privacy-use information for each participant;

computer-readable means for comparing the privacy-use information for each participant to determine matches; and

computer-readable means for only allowing transactions to occur between participants who have matching privacy-use information.

10. (Original) The computer program product of claim 9, wherein said computer-readable means for obtaining comprises at least computer-readable means for requiring each participant in the E-marketplace to present to the E-marketplace their P3P policy.

11. (Original) The computer program product of claim 9, wherein said computer-readable means for obtaining comprises at least:

computer-readable means for presenting each participant with questions that elicit their privacy-use information; and

computer-readable means for storing the elicited privacy-use information for use in said comparing step.

12. (Original) The computer program product of claim 11, wherein said privacy-use information includes at least one of: use information pertaining to elicited email addresses; use of information pertaining to financial information; use of personal information; use of business information, and the delivery of advertising to the participant.

EVIDENCE APPENDIX

No additional evidence is presented.

RELATED PROCEEDINGS APPENDIX

No related proceedings are presented.